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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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KISS CATALOG, LTD.,)
)
Petitioner,)
)
v.)
)
GIRL SQUARED, LLC,)
)
Applicant.)
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Opposition

No. _____



05-30-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #39

Re: Trademark Application:

Applicant: GIRL SQUARED, LLC, a New York limited liability corporation

Mark: KISS AND MAKE-UP

Serial No. 76/220,909

Filed: March 7, 2001

For: Pre-recorded videotapes, CD-ROMs, DVDs, audio cassettes and audio-CDs all featuring children's music, stories, educational content, action adventure, comedy, drama, mystery, animation, live action, live action and animation and photograph; computer game software; electronic computer game programs; video game cartridges; video game software and computer game programs that are downloadable from a global computer network

Class: 09

Published: April 30, 2002

NOTICE OF OPPOSITION

In the matter of an application for registration of the mark "KISS AND MAKE-UP", Serial No. 76/220,909 for Pre-recorded videotapes, CD-ROMs, DVDs, audio cassettes and audio-CDs all featuring children's music, stories, educational content, action adventure, comedy, drama, mystery, animation, live action, live action and animation and photograph; computer game software; electronic computer game programs; video game cartridges; video game software and computer game programs that are

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downloadable from a global computer network (International Class 09), filed under Section 1(b) of the Trademark Act on March 7, 2001 by GIRL SQUARED, LLC, doing business at 270 Lafayette Street, Suite 1301, New York, New York 10012 (hereinafter called "Applicant"), published April 30, 2002, Kiss Catalog, Ltd., a corporation organized under the laws of the State of New York, domiciled and doing business at 7 Irma Avenue, Port Washington, New York 11050 (hereinafter called "Opposer"), believes that it would be damaged by such registration and hereby opposes the same.

The grounds for opposition, on information and belief, are as follows:

1. Opposer, Kiss Catalog, Ltd., is the owner of the intellectual property rights, including trademark rights, pertaining to the musical group KISS, and as such has been engaged in the production of musical entertainment services and in merchandising the term KISS and variations thereof, and the likenesses of the band members on various goods, including necklaces, comic books, photographs, posters, souvenir books, greeting cards, decals, heat transfers, bumper stickers, fan club kits comprising advertising brochures, certificates and souvenirs, cloth patches, buckles, ornamental badges and pins, jigsaw puzzles, paper toys, prerecorded videotapes featuring musical performances and clothing and apparel items.

2. Petitioner has used and presently uses the marks "KISS", "KISS ARMY," "KISS KONFIDENTIAL," "KISS PSYCHO CIRCUS," "KISSNATION," "KISSTORY," and "KISS CONVENTION," in connection with the design, sale and distribution of the goods and services identified in paragraph 1.

3. Petitioner is the owner of the following registrations: "KISS" (Registration No. 1,055,765 dated January 4, 1977); "KISS" (Registration No. 1,153,088 dated May

5, 1981); "KISS" (Registration No. 1,155,932 dated May 26, 1981); "KISS" (Registration No. 1,894,876 dated May 23, 1995); "KISS ARMY" (Registration No. 2,163,803 dated June 9, 1998); "KISS KONFIDENTIAL" (Registration No. 1,916,210 dated September 5, 1995); "KISS PSYCHO CIRCUS" (Registration No. 2,237,588 dated April 6, 1999); "KISS PSYCHO CIRCUS" (Registration No. 1,268,884 dated August 10, 1999); "KISSNATION" (Registration No. 2,106,028 dated October 14, 1997); "KISSTORY" (Registration No. 2,137,991 dated February 17, 1998); "KISS CONVENTION" (Registration No. 1,989,361 dated July 23, 1996); and "KISS CONVENTION" (Registration No. 2,050,016 dated April 1, 1997), which registrations are valid, subsisting and unrevoked. There are additional U.S. registrations pending in Classes 35 and 38.

4. Since prior to the date of first use alleged in Application Serial No. 76/008,081 Opposer and its predecessor did use and have continuously used in interstate commerce the mark "KISS" and variations thereof in connection with the various products and services described in paragraph 1 herein extensively throughout the United States. By reason of such extensive use and promotion, Opposer has attained an enviable reputation for high standards of quality, and the mark KISS and variations thereof have become distinctive of and associated in the minds of the trade and purchasing public with the Opposer.

5. Both Applicant's mark and Opposer's mark contain the term "KISS." Applicant's mark is different only by the addition of the terms "AND MAKE-UP" which do not serve to distinguish Applicant's mark. Because the two marks share an identical term and that term is the dominant portion of the mark, both have a similar commercial

impression. Furthermore, the services of the Applicant are related and/or identical to the various services and products of Opposer as described in paragraph 1 herein, and are likely to move within the same channels of trade and be purchased by the same class of purchaser. Additionally, the members of the musical group KISS employ distinctive facial make-up for which they are well-known. Therefore, the term "make-up" used in connection with the term "kiss" has become associated with the Opposer. As such, Applicant's mark is likely, when used in association with the services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the services of Applicant emanate from, are offered for sale, or are sold by Opposer or under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

6. Opposer believes that Applicant's selection of the mark KISS AND MAKE-UP may take advantage of the nationwide reputation of Opposer and its mark KISS, and combination marks featuring the term KISS, and may take advantage of the goodwill of Opposer gained by extensive and persistent advertising and expenditures of large sums of money therefore, and if continued in commerce, will be likely to confuse, mislead or deceive the trade and members of the public in suggesting to them that Applicant's mark identifies goods and/or services sold, sponsored or approved by Opposer or to suggest falsely a trade connection between Opposer and Applicant.

7. If specified services of Applicant are inferior in quality, there will be irreparable injury to Opposer's valuable goodwill and its registered marks. Furthermore, the use and registration of the mark KISS AND MAKE-UP will dilute the distinctive character of Opposer's valuable registered trademarks, and combination marks featuring the term KISS.


WHEREFORE, Opposer, by and through its counsel, respectfully requests that the mark sought to be registered by Applicant be refused and that a Notice of Opposition be sustained.

Please recognize William H. Cox, William B. Randolph and Peter J. Vranum of the firm of Janvey, Gordon, Herlands, Randolph & Cox, LLP, all members of the Bar of the State of New York, 355 Lexington Avenue, New York, New York 10017, as attorneys for Opposer.

A check for \$300.00 for the opposition fee is attached hereto, together with two copies of the Notice of Opposition.

Respectfully submitted,

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